

### **REMARKS**

The foregoing amendment amends Claims 15, 22 and 23 to clarify the claimed invention. Claims 1-17 and 19-38 are currently pending in this application, with Claims 1-14 and 24-38 being withdrawn. For the reasons set forth below, Applicants believe that the rejections should be withdrawn and that the claims are in condition for allowance.

### **REJECTION OF CLAIMS 15-17 and 19-23 UNDER 35 U.S.C. 112**

#### **Rejection under 35 U.S.C. 112, First Paragraph**

The Examiner rejected Claims 15-17 and 19-23 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner alleged that the term “information provided by an information provider that is distinct from the advertisement” as recited by Claim 15, 22 and 23, is new matter because of the negative limitation.

Applicants respectfully disagree that the term “information provided by an information provider that is distinct from the advertisement” is new matter. The distinction between information provided by the information provider and the advertisement is described throughout the specification as originally filed. However, to facilitate a Notice of Allowance, Claims 15, 22 and 23 have been amended to delete the limitation “that is distinct from the advertisement.” Accordingly, the rejection of Claims 15, 22 and 23 under 35 U.S.C. 112, first paragraph, is now moot.

Claims 16, 17 and 19-21 depend from Claim 15. Accordingly, for at least the same reasons discussed above, the rejection of Claims 16, 17 and 19-21 under 35 U.S.C. 112, first paragraph, is now moot.

#### **Rejection under 35 U.S.C. 112, Second Paragraph**

The Examiner rejected Claims 15-17 and 19-23 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner alleged that the term “information provided by an information provider that is distinct from the advertisement” as recited by Claim 15, 22 and 23, is indefinite.

Applicants disagree that the language “information provided by an information provider that is distinct from the advertisement” is indefinite. As mentioned above, the distinction between the information and the advertisement is described throughout the application. Additionally, as noted in the Office Action, the Examiner recognized that the information is distinct from the advertisement. However, to facilitate a Notice of Allowance, Claims 15, 22 and 23 have been amended to delete the limitation “that is distinct from the advertisement.” Accordingly, the rejection of Claims 15, 22 and 23 under 35 U.S.C. 112, second paragraph, is now moot.

Claims 16, 17 and 19-21 depend from Claim 15. Accordingly, for at least the same reasons discussed above, the rejection of Claims 16, 17 and 19-21 under 35 U.S.C. 112,

#### **REJECTION OF CLAIMS 15-17, 22 AND 23 UNDER 35 U.S.C. 102(e)**

The Examiner rejected Claims 15-17, 22 and 23 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,266,649 to Linden *et al.* (“Linden”). As discussed below, this rejection is respectfully traversed.

Claim 15 as amended describes a method wherein an advertisement providing server interacts with an information provider and an advertisement sponsor to provide an advertisement to a user. Amended Claim 15 requires that information is provided by an information provider and advertisement information is provided by an advertisement providing server on behalf of an advertisement sponsor (*i.e.*, the information provider is just providing information to its users not the advertisement). The advertisement providing server manages the access logs of the information provider and the advertisement information, target information and additional information of the advertisement sponsor. Claim 15 requires that target information, the advertisement information and the additional information is specified by the advertisement sponsor to the advertisement providing server.

#### **An Exemplary Example**

According to an exemplary example described in the specification, the advertisement sponsor may prepare a banner advertisement for a new product or service and may request that the advertisement be provided via the world wide web (“WWW”) to users when users

are viewing target information (*e.g.*, particular web pages) through an information provider (*e.g.*, a web service) that is generally providing product information on the Internet. [0205].

According to one embodiment, the advertisement sponsor provides to the advertisement providing server the advertisement information (*e.g.*, advertisement image, catch phrase, etc.) and the additional information (*e.g.*, a URL of additional content to be viewed by the user who is interested in the advertised new product). [0206]. In some embodiments, the additional information may be provided as a URL link with respect to the advertisement information, as illustrated in Figure 26. In addition, the advertisement sponsor provides to the advertisement providing server target information (*e.g.*, selected web pages) that is related to the advertisement information. [0207].

In addition to managing the advertisement information, additional information and target information provided by the advertisement sponsor, the advertisement providing server manages access logs for accesses made by users with respect to information provided by the information provider. The advertisement providing server also adds access logs of advertisement agents who are virtual users to the access logs indicating that the advertisement agents accessed both the target information and the additional information. *See* [0210].

When a user uses the information provider and accesses information that matches the specified target information (based on the access logs) the user now referred to as the client will be provided with the advertisement by the advertisement providing server. *See* [0209]. The advertisement providing server provides the advertisement to the client. The advertisement providing server also sets the advertisement agents who accessed the target information as related users and extracts the additional information as correlated information, where the additional information was accessed by the related users according to the access logs. *See* [0211].

As described throughout the specification, the advertisement providing server keeps track of the number of times an advertisement is provided and the number of times additional information related to an advertisement is provided. As described above in detail, the advertisement providing server using the access logs can discover the clients who are more

likely to be interested in the new product (based on accessed information matching target information) and the appropriate advertisement information can be provided to those identified clients. As a result, it becomes possible to increase the additional information acquisition count even when the advertisement viewing count remains the same, because providing the appropriate advertisement to a client more likely to be interested in the advertised product permits the client to acquire additional information via the advertisement, for example by clicking a link in the advertisement. In this case, the advertisement providing server increases the additional information acquisition count. *See* [0197] and [0217]. Consequently, by calculating the advertisement fees based on the advertisement viewing count and the additional information acquisition count, it is possible to substantially increase advertising income (i.e., the advertisement fees to be paid by advertisement sponsor to the advertisement providing server). *See e.g.*, [0197] and [0217].

*Distinctions Between the Claimed Invention and the Cited Reference - Linden*

The Examiner alleged that Linden's recommendations service reads on both the advertisement sponsor and the information provider. However, as defined by Claim 15 the advertisement sponsor provides target information, advertisement information and additional information to the advertisement providing server. The advertisement providing server provides the advertisement on behalf of the advertisement sponsor to a client of the information provider who is accessing information that matches the target information (*e.g.*, a web page of an item).

As described above in detail, the information is provided by the information provider and the target information is specified in advance by the advertisement sponsor to the advertisement providing server, so when the information accessed by the client matches the target information, the advertisement providing server delivers the advertisement information on behalf of the advertisement sponsor from the advertisement providing server to the client. The advertisement information is associated with additional information (*e.g.*, web pages of related items or additional product details). The additional information can be accessed from the advertisement information.

In contrast, Linden only produces a recommendations list by combining the similar items lists corresponding to the items known to be of interest to a user, such as items purchased before. Thus the Linden recommendations list is simply a list of names of similar items. Figs. 1 and 6. Linden describes a recommendation service which recommends items to users based on (a) the user's purchase history, (b) the user's item ratings profile (if any), (c) the current contents of the user's personal shopping cart(s), and (d) a listing of items that were recently removed from the shopping cart(s) without being purchased (See Column 7, lines 20-39), and a previously-generated similar items table 60 which maps individual items to lists of similar items with commonality indexes, CI, that indicate the relatedness of the items to the popular items (*See e.g.* Fig. 1, Column 8, line 58 to Column 10, line 3 and Column 9, lines 37-40).

Although Linden does briefly mention that the recommendations list could be presented as advertisements for the recommended items (Col. 11, lines 54-56), Linden is only referring to the manner in which the recommendations list is presented to the user. The recommendations are merely presented to the user as an advertisement containing a list of names of similar items. Linden only discloses providing advertisements of the information provider for the benefit of the information provider.

The specific implementations disclosed by Linden describe that items purchased or placed in the user's shopping cart and/or items purchased or placed in other users' shopping carts are used for making a similarity determination. *See e.g.*, Figures 1 and 3 of Linden and the detailed description disclosed in Column 4, lines 4-5. In particular, Figure 1 shows that the "Purchase Histories" from the user profiles are used by the "Off-Line Table Generation Process" 66 and Figure 3 shows the "Off-Line Table Generation Process" builds a similar items table using information about the purchased items (steps 102 and 104 and tables 102A and 104A). Figure 1 also shows that "Items of Known Interest" from the user profiles are used by the "Recommendation Process" 52 and the Abstract defines the "Items of Known Interest" as items previously purchased by the user. The text accompanying step 80 of Figure 2 describes that "Items of Known Interest" also include items rated by the user. Column 10, lines 37-41. Steps 180 and 290 of Figures 5 and 7 describe that the ratings used

are those provided by the user that receives the recommendation. Figures 5 and 7 do not illustrate that any ratings by other users are used.

The claimed invention requires that the advertisement agents access both the target information and the additional information. The information accessed by the advertisement agents is used for making a correlation or similarity determination in order to deliver advertisement information to the client. However, the Office Action relies upon Lindens' use of items that the user has purchased or intends to purchase to reject the claims. Since a user's purchases differ from a user's access, Linden does not describe the claimed invention. Furthermore since the type of information used to determine the similarity differs, the information provided based on the similarity determination also differs.

Linden does not disclose or suggest an advertisement providing server providing advertisements where the advertisement information and additional information is provided by a third-party advertisement sponsor. As described above, Linden provides recommendations lists based on items known to be of interest to the user, Linden does not provide recommendations lists based on advertisement information and additional information specified by an advertisement sponsor. In the present invention an advertisement sponsor provides specific target information, advertisement information and associated additional information to an advertisement providing server and the advertisement sponsor requests that the advertisement providing server provide the advertisement to a user of an information provider when (based on the access logs) the user is accessing information that matches the designated target information.

The server of Linden does not receive target information from an advertisement sponsor. More importantly, the server of Linden does not receive advertisement information and associated additional information from an advertisement sponsor, but instead the server of Linden simply provides a list of recommended items based on items known to be of interest to the user. The recommendations list of Linden is not comparable to the advertisement of Claim 15 where the advertisement information and the associated additional information is provided to the advertisement providing server by an advertisement sponsor. Linden discloses a recommendation service that is a part of the server that also provides

items put into the shopping cart by the user. Therefore, the recommendation service disclosed in Linden is actually the recommendation made by the server itself, and thus not based on advertisement information and additional information provided by an advertisement sponsor, as required by Claim 15.

Linden also does not describe using the user's access of the target information as a trigger for providing the advertisement on behalf of the advertisement sponsor. Linden does not disclose providing a sponsored advertisement to the user of the information provider who is accessing target information, where the target information is *specified in advance* by the advertisement sponsor, as required by Claim 15. (*emphasis added*). The shopping cart data of Linden does not disclose the target information specified in advance by the advertisement sponsor, as claimed by Claim 15, since the shopping cart data is maintained by the same server that manages the access logs. Neither the shopping cart data nor any other data of Linden includes target information specified in advance by an advertisement sponsor. As defined by Claim 15 the target information is specified in advance by the advertisement sponsor.

Moreover, Linden does not disclose the manipulation of access logs. Claim 15 requires adding access logs of advertisement agents who accessed the target information and the additional information. Linden does not suggest adding access logs of advertisement agents to the access logs, where the advertisement agents accessed the target information and the additional information. The Examiner cited Column 3, lines 1-3 of Linden for allegedly disclosing the addition of access logs of advertisement agents. The cited section of Linden describes generating item-to-item mappings by analyzing user purchase histories to identify correlations. (Col. 3, lines 1-3). Linden does not describe manipulating the purchase histories by adding purchase histories of users, where the users accessed specific target information and additional information. Linden does not suggest of disclose manipulating access logs by adding access logs of advertisement agents to the access logs, where the advertisement agents accessed the target information and the additional information, as required by Claim 15.

Consequently, Linden does not disclose an advertisement providing server that based on access logs provides a user who is accessing target information (*e.g.*, a particular web page) with an advertisement that is associated with additional information (*e.g.*, another web page), where the target information, the advertisement information and the additional information is provided by an advertisement sponsor. Accordingly, Claim 15 is not anticipated by Linden.

The foregoing amendment amends Claims 22 and 23 in a manner similar to Claim 15. Accordingly, for at least the same reasons discussed above, Claims 22 and 23 are patentable over Linden.

Claims 16 and 17 depend from Claim 15. Accordingly, for at least the same reasons discussed above, Claims 16 and 17 are patentable over Linden.

Moreover, with regard to Claim 16, Linden does not disclose “potential target information.” As defined by Claim 16, the advertisement providing server adds access logs of other advertisement agents to the access logs, where the other advertisement agents accessed the additional information and the potential target information. According to the embodiment defined by Claim 16, where the potential target information is recorded in the access logs of other advertisement agents, it is then possible for the advertisement providing server based on the access logs to provide an advertisement to other clients who accessed the potential target information but who have not accessed the target information itself. In other words, based on the potential target information of Claim 16, it is possible to deliver the advertisement to those clients who are potentially likely to have interests in that advertisement, although those clients did not access the target information directly.

The cited section of Linden describes the updating of item-to-item mappings, where the updating of the mappings is based analyzing user purchase histories to identify correlations. (Col. 5, line 57 to Col. 6, line 2). The updating of item-to-item mappings based on correlations between purchases of particular items according to purchase histories is not comparable to the potential target information of Claim 16. Linden does not describe or suggest an advertisement providing server determining related users who accessed the target information, extracting the potential target information accessed by those other users, adding



access logs of other advertisement agents to the access logs, where the other advertisement agents accessed the potential target information, and based on the access logs providing a second advertisement to other clients, where the other clients accessed the potential target information, as required by Claim 16. Claim 16 is patentable over Linden.

**CONCLUSION**

The foregoing is submitted as a complete response to the Office Action identified above. This application should now be in condition for allowance, and the Applicants solicit a notice to that effect. No fees are believed due, however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account 11-0855. If there are any issues that can be addressed via telephone, the Examiner is asked to contact the undersigned at 404.685.6799.

Respectfully submitted,

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